

**SECTION 45 PROCEEDINGS**  
**TRADE-MARK: ORIENTAL EXPRESS & Design**  
**REGISTRATION NO.: TMA 396,096**

On January 16, 1997, at the request of 88766 Canada Inc., the Registrar forwarded a Section 45 notice to Choi Trading Company Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark ORIENTAL EXPRESS & Design is registered for use in association with the following services:

- (1) Oriental restaurant services.

In response to the Registrar's notice, the registrant furnished the affidavit of Irene Choi. Each party filed a written submission. An oral hearing has not been requested in this case.

In her affidavit, Ms. Choi states that the trade-mark has been in continuous use since 1992 in association with oriental restaurant services. She indicates that the trade-mark has been used by the owner and thereafter by licensed users, wherein the owner maintained control over the character and quality of the services.

She specifies that the restaurant is located at 121 King Street West, Toronto, Ontario, which is the Standard Life Building in downtown Toronto. She states that the trade-mark is clearly displayed on the bulkhead of the restaurant while a modified version of the trade-mark is shown on a glass panel in the centre of the entrance to the restaurant. She has enclosed a copy of an architectural sketch of the front of the restaurant which she states shows the trade-mark. She specifies that the bulkhead with the trade-mark ORIENTAL EXPRESS & Design has been in continuous use since 1992 by the owner and thereafter its licensed users. She also specifies that the modified trade-mark on the glass panel has been used initially in conjunction with the trade-mark HO SHIM and thereafter to the present with the trade-mark HO GA. She indicates that daily sales average \$800.00.

I am satisfied from the evidence that the registrant through its licensed user operates and has operated during the relevant period and oriental restaurant and that the registrant has control of the character and quality of the services as required by Section 50 of the Act. The issue, however, is whether the trade-mark displayed in association with the restaurant (as shown on the sketch attached as Exhibit A) constitutes use of the registered trade-mark.

I reproduce below the trade-mark as registered. I also reproduce below the trade-mark as it appears on the bulkhead of the restaurant and as it appears on the glass panel in the centre of the entrance to the restaurant.

trade-mark as registered.

trade-mark appearing on bulkhead (Exhibits A & B)

trade-mark appearing on glass panel (Exhibits A & B)

Concerning the trade-mark as it appears on the bulkhead of the restaurant, in my view, such use could be perceived as use of the registered trade-mark. Although the design, the H within a circle, is somewhat distanced from the words “ORIENTAL EXPRESS” it is nevertheless linked to such words, as there is a line attached to the “design” that connects the design to the words. This is clearly a borderline case. However, as stated in *Promafil Canada Ltee. v. Munsingwear Inc.*, 44 C.P.R. (3d) 59, at p. 71:

In the words of MacLean P., “the practice of departing from the precise form of a trade-mark as registered... is very dangerous to the registrant”. But cautious variations can be made without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead the unaware purchaser.

...

The law of trade marks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trade mark owner acting in good faith... It demands only such identity as maintains recognizability and avoids confusion on the part of the unaware purchasers.

In my view, as both elements of the trade-mark appear on the bulkhead of the restaurant and as they are clearly linked together, I am prepared to conclude that the words are as likely to be perceived as forming one trade-mark as forming two separate trade-marks.

Concerning the copy of the architectural sketch of the front of the restaurant, Ms. Choi has clearly alleged under oath that it shows the manner the trade-mark is displayed on the bulkhead of the restaurant, and I see no reason not to accept her statement.

Concerning the trade-mark appearing on the glass panel, I agree with the requesting party that such use does not constitute use of the registered trade-mark but of a completely different trade-mark.

Nevertheless, as I have found that the use of the trade-mark appearing on the bulkhead of the restaurant constitutes use of the registered trade-mark, I conclude that the trade-mark registration ought to be maintained on the register.

Registration No. TMA 396,096 will be maintained accordingly in compliance with the requirements of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 7th DAY OF July, 1998.

D. Savard  
Senior Hearing Officer  
Section 45